

REMARKS

This Reply and Amendment is intended to be completely responsive to the Non-Final Office Action dated February 13, 2003. Claims 1-12 are pending in this Application. Claims 1-12 stand rejected. Upon entry of this Amendment, independent Claims 1, 9 and 10 will be amended.

Claim Rejections – 35 U.S.C. § 103

Claims 1-9

On page 1 of the Office Action, the Examiner rejected independent Claims 1 and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,225,004 to Hayashi ("Hayashi") in view of U.S. Patent No. 5,827,494 to Yano et al. ("Yano et al.").

Hayashi discloses a "nickel positive electrode for alkaline storage batteries and method for producing the same." Yano et al. discloses a "process for producing non-sintered nickel electrode for alkaline battery." The Examiner acknowledged that Hayashi "does not teach the inclusion of an aluminum compound in the positive electrode."

Independent Claims 1 and 9 have been amended. Claims 2-8 depend from Claim 1. Claims 1 and 9 now recite a "Ni/metal hybrid secondary element" comprising an aluminum compound that is added to the bulk material of the positive electrode and "wherein the aluminum compound becomes dissolved into the electrolyte and modifies surface portions of the positive electrode when the element is charged." The "Ni/metal hybrid secondary element" as recited in Claims 1 and 9, as amended, is not disclosed, taught or suggested by Hayashi, alone or in any proper combination with Yano et al.

The suggestion to make the combination of Hayashi and Yano et al. has been taken from the Applicant's own specification (using hindsight) which is improper. Furthermore, to transform the "nickel positive electrode for alkaline storage batteries and method for producing the same" of Hayashi, alone or in any proper combination with the "process for producing non-sintered nickel electrode for alkaline battery" of Yano et al., into a "Ni/metal

hydride secondary element" comprising in combination with other recited elements an aluminum compound that is added to the bulk material of the positive electrode and "wherein the aluminum compound becomes dissolved into the electrolyte and modifies surface portions of the positive electrode when the element is charged" as recited in Claims 1 and 9, as amended, would require still further modification, and such modification is taught only by Applicant's own disclosure.

The subject matter recited in Claims 1 and 9, as amended, considered as a whole, would not have been obvious under Hayashi in view of Yano et al. under 35 U.S.C. § 103(a). Claims 2-8 depend from Claim 1 as amended.

Applicants respectfully request allowance of Claims 1-9.

Claims 10-11

On page 3 of the Office Action, the Examiner rejected Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,225,004 to Hayashi ("Hayashi") in view of U.S. Patent No. 5,827,494 to Yano et al. ("Yano et al."). Claim 11 depends from independent Claim 10.

Hayashi discloses a "nickel positive electrode for alkaline storage batteries and method for producing the same." Yano et al. discloses a "process for producing non-sintered nickel electrode for alkaline battery." The Examiner acknowledged that Hayashi "does not teach the inclusion of an aluminum compound in the positive electrode."

The subject matter recited in Claim 10 would not have been obvious over Hayashi in view of Yano et al. under 35 U.S.C. § 103(a). Claim 10 describes a "Ni/metal hybrid secondary element" comprising an aluminum compound that is added to the bulk material of the positive electrode and "that upon charging the element, the aluminum compound dissolves into the electrolyte and forms a thin, porous and/or ion-conductive film of $\text{Al}(\text{OH})_3$ on surface portions of the positive electrode." The "Ni/metal hybrid secondary

element" as recited in Claim 10 is not disclosed, taught or suggested by Hayashi, alone or in any proper combination with Yano et al.

The suggestion to make the combination of Hayashi and Yano et al. has been taken from the Applicant's own specification (using hindsight) which is improper. Furthermore, to transform the "nickel positive electrode for alkaline storage batteries and method for producing the same" of Hayashi, alone or in any proper combination with the "process for producing non-sintered nickel electrode for alkaline battery" of Yano et al., into a "Ni/metal hydride secondary element" comprising in combination with other recited elements an aluminum compound that is added to the bulk material of the positive electrode and "that upon charging the element, the aluminum compound dissolves into the electrolyte and forms a thin, porous and/or ion-conductive film of $\text{Al}(\text{OH})_3$ on surface portions of the positive electrode" as recited in Claim 10, would require still further modification, and such modification is taught only by Applicant's own disclosure.

The subject matter recited in Claim 10, considered as a whole, would not have been obvious under Hayashi in view of Yano et al. under 35 U.S.C. § 103(a). Claim 11 depends from Claim 10.

Applicants respectfully request allowance of Claims 10-11.

Claim 12

On page 3 of the Office Action, the Examiner rejected independent Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,225,004 to Hayashi ("Hayashi") in view of U.S. Patent No. 5,827,494 to Yano et al. ("Yano et al.").

Hayashi discloses a "nickel positive electrode for alkaline storage batteries and method for producing the same." Yano et al. discloses a "process for producing non-sintered nickel electrode for alkaline battery." The Examiner acknowledged that Hayashi "does not teach the inclusion of an aluminum compound in the positive electrode."

The subject matter recited in Claim 12 would not have been obvious over Hayashi in view of Yano et al. under 35 U.S.C. § 103(a). Claim 12 describes a "method of forming an active positive electrode in a battery containing a negative electrode and an electrolyte" by "mixing an aluminum compound soluble in the electrolyte, nickel hydroxide and cobalt to form a bulk material." Claim 12 comprises "causing portions of the aluminum compound to dissolve from the structure into the electrolyte by charging the battery." The "method" as recited in Claim 12 is not disclosed, taught or suggested by Hayashi, alone or in any proper combination with Yano et al.

The suggestion to make the combination of Hayashi and Yano et al. has been taken from the Applicant's own specification (using hindsight) which is improper. Furthermore, to transform the "nickel positive electrode for alkaline storage batteries and method for producing the same" of Hayashi, alone or in any proper combination with the "process for producing non-sintered nickel electrode for alkaline battery" of Yano et al., into a "method of forming an active positive electrode in a battery containing a negative electrode and an electrolyte" comprising in combination with other recited elements "mixing an aluminum compound soluble in the electrolyte, nickel hydroxide and cobalt to form a bulk material" and "causing portions of the aluminum compound to dissolve from the structure into the electrolyte by charging the battery" as recited in Claim 12, would require still further modification, and such modification is taught only by Applicant's own disclosure.

The subject matter recited in Claim 12, considered as a whole, would not have been obvious under Hayashi in view of Yano et al. under 35 U.S.C. § 103(a).

Applicants respectfully request allowance of Claim 12.

* * *

No new matter has been added.

The Applicant respectfully submits that each and every outstanding rejection to the pending claims has been overcome, and the Application is in condition for allowance. The Applicant respectfully requests entry of the Amendment and reconsideration and allowance of the pending Claims 1-12.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 7/14/03

By Scott M. Day

FOLEY & LARDNER
777 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-5367
Telephone: (414) 297-5872
Facsimile: (414) 297-4900

Scott M. Day
Attorney for Applicant
Registration No. 52,801